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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,354	03/01/2004	Rainer Kropke	104035.274384	2393
826	7590	11/02/2005		
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/791,354	KROPKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-12,14-17 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12,14-17 and 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/29/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 7/29/05. Claims pending are 1-3, 5-12, 14-17 and 19-30. Claims 4, 13 and 18 have been cancelled. Claims 1, 6, 10 and 15 have been amended. Claims 23-30 are new.

### ***Priority***

1. Receipt of the translation of the foreign priority document is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 6-12, 15-17 and 20-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Claims 1, 10 and 15, as amended**, introduce new matter as they recite the limitation "wherein said amount [of iminodisuccinic acid or salt thereof] is at least 0.1% by weight, based on the total weight of the formulation". There is no support in the specification for this limitation. The specification discloses the concentration range of from 0.001% to 15% by weight and the original claims provide support for the concentration range from 0.1 to 0.5% by weight. However, the Applicants' disclosure

Art Unit: 1616

fails to reasonably describe the instantly claimed open-ended range of "at least 0.1% by weight", which reads on concentrations as high as 99.9% by weight. There is no indication in the specification that the upper level of iminodisuccinic acid or salt thereof may be above 15% by weight. It is the examiner's position that the disclosure does not reasonably convey that the inventor has possession of the subject matter of the amendment at the time of filing of the instant application. The amended claims recite the range which was not clearly disclosed in the specification as filed, and now change the scope of the instant disclosure as filed. Such range limitation recited in the present claims, which did not appear in the specification, as filed, introduces a new concept and violates the description requirement of the first paragraph of 35 U.S.C. 112. MPEP 2163.05 provides as follows: "With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. In the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of "25%- 60%" and specific examples of "36%" and "50%." A corresponding new claim limitation to "at least 35%" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range, however a limitation to "between 35% and 60%" did meet the description requirement." This is exactly the case here, the new claim limitation "at least 0.1%" reads of on

embodiments outside the "0.001 to 15%" range, and, therefore, does not meet the description requirement.

Further, **new Claims 27 and 28** introduce new matter as they recite the limitations "wherein the cosmetic or dermatological formulation exhibits an optical effect discernible when viewed through translucent or transparent packaging" and "wherein the optical effect is selected from the group consisting of colored pigments and gas bubbles." There is no support in the specification for these claims. The limitations of new Claims 27 and 28 were not described in the application as filed, and persons skilled in the art would not recognize in the applicant's disclosure a description of the invention as presently claimed. In the "Background of the Invention" section of the instant specification, the Applicants mention that "interesting optical effects can be imparted to the product, which is then as a rule presented to the observer in transparent packaging, by incorporated colored pigments, gas bubbles and the like, or also larger objects." See p. 1 of the specification. However, this statement does not describe the Applicants' invention, but merely recites an "interesting" possibility. Therefore, it is the examiner's position that the disclosure does not reasonably convey that the inventor has possession of the subject matter of the amendment at the time of filing of the instant application.

*Applicants are required to cancel the new matter in the response to this Office action. Alternatively, the Applicants are invited to point out to the parts of the*

*specification which provide sufficient written support for the above-mentioned open-ended range. See MPEP 714.02 and 2163.06.*

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3, 5, 7-12, 14, 23, 24, 26, 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Argembeaux et al. (EP 1 074 239, translation).

Argembeaux et al. teach cosmetic hair care compositions in the form of emulsions and solutions, containing complexing agents such as imino disuccinic acid or salts thereof (e.g. tetrasodium salt). See p. 12 of the translation, [0033]; p. 15, [0042]-[0043]; p. 24, [0067]. Examples 4-6 of Argembeaux et al. show compositions containing 0.2, 0.3 and 0.8% of imido (sic!) disuccinic acid, Na salt. See p. 25. The compositions of Argembeaux et al. may contain UV absorbers to protect the hair or the skin from UV radiation. See p. 21, [0057]. Argembeaux et al. teach that the cosmetic compositions "can change disadvantageously in their appearance and/or smell under the influence of light and/or heat or after long periods of storage, because their concentration of free polyvalent metal cations is too high. It was the object of the invention to eliminate the disadvantages of the state of the art." See p. 8, [0017]-[0018]. The compositions of Argembeaux et al. "remain stable over the long period of time in their effectiveness and their cosmetic impression." See p. 8, [0018]. With

respect to Claim 27, which recites visible optical effects, the reference teaches pearlescent compositions. See Examples 1-3 @ p. 24.

Thus, Argembeaux et al. teach each and every limitation of Claims 1-3, 5, 7-12, 14, 23, 24, 26, 27 and 29.

6. Claims 10, 12, 14 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt (US 6,495,718), of record.

Schmidt exemplifies a cosmetic composition containing 0.1% of iminodisuccinate sodium salt. See col. 5, lines 54-67; col. 6, lines 19-40.

Thus, Schmidt teaches each and every limitation of Claims 10, 12, 14 and 24.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 6, 15-17, 19-22, 25, 27, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Argembeaux et al. (EP 1 074 239, translation) in view of either Dallal et al. (US 5,059,414) or Koike et al. (US 6,461,623), both of record.

Argembeaux et al. applied as above. The reference does not explicitly teach the claimed transparent or translucent packaging. However, transparent or translucent packaging is known and widely used in the art of cosmetic products for either aesthetic or practical purpose, or both. Thus, Dallal et al. teach packaging multi-phase cosmetic products in transparent container for the desired visual effect. See col. 8, lines 54-56. Koike et al. teach using transparent containers for ascertaining as completely dispersed

Art Unit: 1616

state of the cosmetic composition. See col. 6, lines 5-10. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Argembeaux et al. such that to package them in transparent containers. One having ordinary skill in the art would have been motivated to do this to obtain the aesthetic appeal of the product and/or to ensure the homogeneity of the composition before applying it to the skin/hair as suggested by either Dallal et al. or Koike et al. With respect to Claim 25, Argembeaux et al. does not explicitly teach transparent or translucent cosmetic formulations. However, Dallal et al. teach that clarity, among other characteristics, is "utilized to win consumer enticement or acceptance." See col. 1, lines 34-42.; col. 3, lines 33-43. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Argembeaux et al. such that to make them clear. One having ordinary skill in the art would have been motivated to do this to obtain the aesthetic appeal of the product as suggested by Dallal et al. With respect to Claims 27 and 28, Argembeaux et al. does not explicitly teach optical effects such as colored pigments or gas bubbles as claimed herein. However, Dallal et al. teach visual effects such as stripes, alternate colors or sparkles in order to achieve "visually distinctive and pleasing appearance" of the products. See Abstract; col. 2, lines 51-60; col. 3, lines 40-43. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Argembeaux et al. such that to incorporate optical effects. One having ordinary skill



in the art would have been motivated to do this to obtain the visually distinctive and pleasing appearance of the cosmetic products as suggested by Dallal et al.

***Response to Arguments***

9. The rejection of the instant claims over Cowan et al. (US 2,594,294) has been withdrawn in view of the Applicants' amendment and arguments.

10. The rejection of the instant claims over Fernandez-Kleinlein et al. (WO 02/19981) has been withdrawn in view of the Applicants' filing of the translation of the foreign priority document.

11. Applicant's arguments with respect to the 102(e) rejection of Claims 10 and 12-14 over Schmidt (US 6,495,718) have been fully considered but they are not persuasive.

The Applicant argues: "In response to this rejection, Applicants note that Schmidt does not teach or suggest a cosmetic or dermatological formulation comprising iminodisuccinic acid or a salt thereof in an amount sufficient to increase at least one of the color-stability and the light-stability of a cosmetic or dermatological formulation, as provided in the claims of the present application. Schmidt actually teaches that the cosmetic formulation with 0.1% iminodisuccinic acid sodium salt, as tested in Schmidt, has virtually no effect on color or light stability (column 6, lines 38-39, 49-51)." See p. 7 of the reply.

In response, the exemplified composition of Schmidt anticipates the instant claims 10, 12 and 14 because it teaches cosmetic compositions containing 0.1% of iminodisuccinate, Na salt. The amount of the sodium iminodisuccinate taught by the reference is the same as claimed herein, therefore, it is inherently "sufficient to increase at least one of the color-stability or the light-stability of a cosmetic or dermatological formulation."

12. Applicant's arguments with respect to claims 1-3, 5-9, 11, 15-17 and 19-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

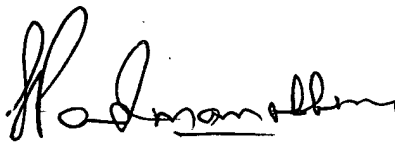
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm  
10/21/05

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER